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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/609,891	07/05/2000	Joseph W. Luciano	LE9-00-044	5238

21972 7590 01/13/2003

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EXAMINER

GARCIA, GABRIEL I

ART UNIT

PAPER NUMBER

2624

DATE MAILED: 01/13/2003

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Application No.

09/609,891

Applicant(s)

Luciano et al.

Examiner

H. Marcia

Art Unit

2624

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE three MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136 (a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 10/28/02.
- 2a) ☐ This action is FINAL. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11; 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-2, and 6-23 is/are pending in the application.
- 4a) Of the above, claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1-2, 6-17, and 21-23 is/are rejected.
- 7) ☒ Claim(s) 18-20 is/are objected to.
- 8) ☐ Claims _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
- 11) ☐ The proposed drawing correction filed on _____ is: a) ☐ approved b) ☐ disapproved by the Examiner.
If approved, corrected drawings are required in reply to this Office action.
- 12) ☐ The oath or declaration is objected to by the Examiner.

Priority under 35 U.S.C. §§ 119 and 120

- 13) ☐ Acknowledgement is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
a) ☐ All b) ☐ Some* c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. _____.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
*See the attached detailed Office action for a list of the certified copies not received.
- 14) ☐ Acknowledgement is made of a claim for domestic priority under 35 U.S.C. § 119(e).
a) ☐ The translation of the foreign language provisional application has been received.
- 15) ☐ Acknowledgement is made of a claim for domestic priority under 35 U.S.C. §§ 120 and/or 121.

Attachment(s)

- 1) ☒ Notice of References Cited (PTO-892) 4) ☐ Interview Summary (PTO-413) Paper No(s). _____
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948) 5) ☐ Notice of Informal Patent Application (PTO-152)
- 3) ☐ Information Disclosure Statement(s) (PTO-1449) Paper No(s). _____ 6) ☐ Other:

Part III DETAILED ACTION

1. In view of the newly found prior art and Applicant's arguments on the Appeal Brief filed on 10/28/02, PROSECUTION IS HEREBY REOPENED. New grounds of rejection are set forth below.

To avoid abandonment of the application, appellant must exercise one of the following two options:

(1) file a reply under 37 CFR 1.111 (if this Office action is non-final) or a reply under 37 CFR 1.113 (if this Office action is final); or,

(2) request reinstatement of the appeal.

If reinstatement of the appeal is requested, such request must be accompanied by a supplemental appeal brief, but no new amendments, affidavits (37 CFR 1.130, 1.131 or 1.132) or other evidence are permitted. See 37 CFR 1.193(b)(2).

Claim Rejections - 35 USC § 102

2. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless -

(e) the invention was described in a patent granted on an application for patent by another filed in the United States before the invention thereof by the applicant for patent, or on an international application by another who has fulfilled the requirements of paragraphs (1), (2), and (4) of section 371[©] of this title before the invention thereof by the applicant for patent.

The changes made to 35 U.S.C. 102(e) by the American Inventors Protection Act of 1999 (AIPA) do not apply to the examination of this application as the application being examined was not (1) filed on or after November 29, 2000, or (2) voluntarily published under 35 U.S.C. 122(b). Therefore, this application is examined under 35 U.S.C. 102(e) prior to the amendment by the AIPA (pre-AIPA 35 U.S.C. 102(e)).

3. Claims 1-2 and 6-12 are rejected under 35 U.S.C. 102(e) as being anticipated by Ozawa et al. (6,445,461).

With regard to claim 1, Ozawa et al. teaches a photoprinter configuration (see figures 1-4, which depicts a system to print photographs using a digital camera and a digital printer) comprising: a digital camera (10) comprising a viewable display (34) and one or more selection mechanisms (see fig. 2, item 38 or fig. 4, items 38(a-d) and 44a); and a photoprinter (12) capable of processing and printing digital files independent of an external host device (which clearly reads on fig. 1-3, which depicts how the camera and printer interact independent of an external host device, also col. 1, lines 64-67, described how a digital camera can transmit image data to a printer without the intervention of any computer) and connected to the digital camera via a communication link (see fig. 1, item 14, that represents the communication link between the digital camera and the

printer), the photoprinter being operative to control the viewable display of the digital camera (reads on figs. 10-12, which depicts how the printer controls the viewable LCD of the camera by sending the conversion software, by changing the paper size or zooming the image as depicted in figs. 9(a-d)).

With regard to claim 2, Ozawa et al. teaches the photoprinter is further operative to direct a result from a user's input to the selection mechanisms (reads on fig. 3, items 60 and 62, which allow user to select operations and implement these operations as described in steps S9 and S49, which allow the user(s) to select the mode of the printer and the zooming of an image).

With regard to claim 6, Ozawa et al. further teaches means for controlling the digital camera by the photoprinter (reads on the CPU ability to send the conversion software as described on figs. 10 and 11).

With regard to claim 7, Ozawa et al. teaches a method for controlling a digital camera (10), comprising a) obtaining a photoprinter capable of processing and printing digital files independent of an external host device and operative to print digital photographs onto printable media (which clearly reads on fig. 1-3, which depicts how the camera and printer interact independent of an external host device, also col. 1, lines 64-67, described how a digital camera can transmit image data to a printer without the intervention of any computer) ; b) obtaining

a digital camera comprising a viewable display and one or more selection mechanisms (see fig. 2, item 38 or fig. 4, items 38(a-d) and 44a); c) connecting the digital to the photoprinter via a communication link (see fig. 1, item 14, that represents the communication link between the digital camera and the printer); d) transmitting a plurality of instructions from the photoprinter to the digital camera via the communication link (reads on fig. 3, items 60 and 62, which allow user to select operations and implement these operations as described in steps S9 and S49, which allow the user(s) to select the mode of the printer and the zooming of an image, and the instructions send to the camera from the printer to convert the data to a format understood by the printer as described on figs. 10 and 11); and e) controlling the digital camera by the photoprinter in accordance with a plurality of instructions (reads on the CPU ability to send the conversion software as described on figs. 10 and 11 having instructions to convert the data to a format understood by the printer and the ability to zoom or view the image as depicted in figs 9(a-d)).

With regard to claim 8, Ozawa et al. further teaches the instructions are operative to preview digital photographs on the viewable display (reads on figs 9(a-d), which shows the image(s) before are printed).

With regard to claims 9-10, Ozawa et al. teaches the instructions are operative to present a user interface on the

viewable display, also to direct an operation of the photoprinter based on input to the selection mechanism (reads on figs 7-8, which allow user to select operations and implement these operations as described in steps S9 and S49, which allow the user(s) to select the mode of the printer and/or the zooming of an image).

With regard to claim 11, Ozawa et al. teaches to select digital photographs for printing based on input to the selection mechanism (reads on items 38 and 40 of fig. 2, and items 60 and 62 which allow the user(s) to select data).

With regard to claim 12, Ozawa et al. teaches to modify a printed rendition of digital photographs based on input to the selection mechanism (reads on items 38 and 40 of fig. 2, and items 60 and 62 which allow the user(s) to select data and to select an operation such as zooming as depicted in fig. 10).

Claim Rejections - 35 USC § 103

4. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

5. Claims 13-17 and 21-23 are rejected under 35 U.S.C. 103(a) as being unpatentable over Ozawa et al. (6,445,461) in view of Taniguchi et al. (5,999,707).

With regard to claim 13, Ozawa et al. teaches a printer configuration, comprising: a) a host computer (112); b) a peripheral device (110); c) a stand alone printer (114) connected via a communication link (118 or the infrared communication) to the host computer and the peripheral device (see col. 9, line 58 thru col. 10, line 11), wherein the stand alone printer is operable as a client to the host (clearly reads on the ability of the host computer to send data to the printer using the universal infrared communication as described in col. 9, lines 1-11), as a host for the peripheral device (which reads on figs 5,6 and 10, which allow the printer to control the digital camera), Ozawa et al. teaches fails to teach the photoprinter as a passthrough device such that the host computer may initiate request to the peripheral. Taniguchi et al. teaches that it is well known in the art to make a printer operate as a client to a host computer and to communicate data to client (see abstract). Therefore, it would have been obvious to one having ordinary skill in the art at the time the invention was made to provide the infrared communication as taught by Ozawa et al with the means to allow the printer to operate as a host to the printer because of the following reasons as taught by Taniguchi et al.: a) in order to allow the printer

of Ozawa et al. to select information from the host as to operate the digital camera and to control information between the camera and the host computer; b) in order to allow the printer of Ozawa et al. to be an intelligent printer that allows the manipulation of the camera and the receiving of information from the host; and c) in order to provide the infrared communication of the printer with the ability to select a device to communicate allowing the system to relay information received from a different source.

With regard to claim 14, Ozawa et al. teaches wherein the standalone printer is a photoprinter (see fig 1 and 3).

With regard to claim 15, Ozawa et al. teaches wherein the peripheral device is a digital camera (see fig. 1, item 10).

With regard to claim 16, Ozawa et al. teaches wherein the standalone printer comprises a means for receiving and sending data via the communication link (see fig. 1, the communication 14 allow the sending and receiving of data by way of the infrared communication interface).

With regard to claim 17, Ozawa et al. teaches wherein the communication link is a universal serial bus (see col. 10, lines 9-11).

With regard to claims 21-23, the limitations of claims 21-23 are covered by the limitations of claims 13-17 above.

Conclusion

6. Claims 18-20 are objected to as being dependent upon a rejected base claim, but would be allowable if rewritten in independent form including all of the limitations of the base claim and any intervening claims. The prior art of record does not teach (in combination with all other features in the claims) a printer configuration wherein the stand alone printer comprises a universal serial bus device controller, a universal serial bus host controller, and a processor interface operative to control the universal bus device controller and universal serial bus host controller.

7. Applicant's arguments with respect to the pending claims have been considered but are moot in view of the new ground(s) of rejection. **THIS OFFICE ACTION IS MADE NON FINAL.**

8. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Gabriel I. Garcia whose telephone number is (703) 305-8751. The examiner can normally be reached Monday thru Thursday from 7:30AM-6:00PM.

Any inquiry of a general nature or relating to the status of this application should be directed to the Group receptionist whose telephone number is (703) 306-0377.

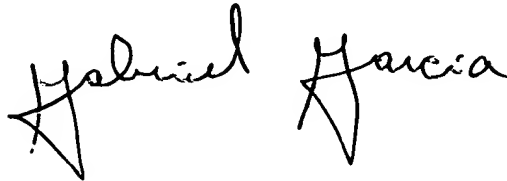
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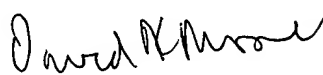
or faxed to:

(703) 872-9314 (official or unofficial)

Gabriel I. Garcia
Primary Examiner
January 11, 2003



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